

AMENDMENTS TO THE DRAWINGS

One Replacement Sheets of drawings is attached hereto as Appendix A, following page 19 of this paper. The Replacement Sheet includes amended FIG. 1B, which replaces originally submitted FIG. 1B. In response to the Examiner's drawings objection stated in paragraph 3 of the Office Action, FIG. 1B has been amended to show a line connecting elements 101 and 101b. Applicants submit that no new matter has been introduced.

REMARKS / ARGUMENTS

The present application includes pending claims 1-29, all of which have been rejected. Applicants have amended portions of the specification as set forth above to correct minor typographical errors. Applicants have also amended claims 1-2, 5-8, 11-12, 14, 16, 20, 23, and 25 to further clarify the language used in these claims and to address the claim objections stated in paragraph 4 of the Office Action. Applicants do not believe that these amendments affect allowability of the claims.

Claims 1-3, 5-17, and 19-29 stand rejected under 35 U.S.C. § 102(b) as being anticipated by US Patent No. 5,742,905, issued to Pepe, et al. (hereinafter, Pepe). Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Pepe. Claim 18 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Pepe in view of U.S. Patent Application Publication 2004/0132403 issued to Alba (hereinafter, Alba). Applicants request reconsideration of the claims in view of the amendments and the following remarks.

Claim Objections under 35 U.S.C. § 112

(paragraphs 5 and 6 of the Office Action)

Applicants have amended claim 20 to address the Examiner's rejection under 35 USC § 112, second paragraph. The Applicants submit that no new matter has been entered by the amendment of claim 20.

Claim Rejections under 35 U.S.C. § 102

(paragraphs 7 and 8 of the Office Action)

Claims 1-3, 5-17, and 19-29 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Pepe.

With regard to the anticipation rejections under Pepe, MPEP 2131 states that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 2 USPQ2d 1051, 1053 (Fed.Cir. 1987). MPEP 2131 also states that "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

With regard to the rejection of independent claim 1 under Pepe, Applicants submit that Pepe does not disclose or suggest at least the limitation of "a plurality of communication devices operatively coupled to a network, the plurality of communication devices comprising a native communication device," as claimed by Applicants in independent claim 1. More specifically, Pepe does not teach or suggest that the plurality of communication devices, such as the devices shown in Figure 3 of Pepe, comprise a native communication device. The Office Action refers for support to "home location register," disclosed by Pepe in col.2, lines 10-13. The Applicants submit that the home location register (HLR) is not a communication device. The HLR is used by Pepe to store customer profile data and the location of the Visiting Location Register (VLR) (Pepe, column 2, lines 7-30).

Further with regard to the rejection of independent claim 1 under Pepe, Applicants submit that Pepe does not disclose or suggest at least the limitation of "a media device operatively coupled to the native communication device and the network, the media device being associated with the native communication device and the network, the media device during operation exchanging media content with the plurality of communication devices and the network," as claimed by

Applicants in independent claim 1. As shown, for example, in Figure 3 of Pepe, Pepe does not disclose or suggest a media device that is associated with a native communication device and a network, where the media device during operation exchanges media content with the plurality of communication devices and the network, as disclosed by Applicants in claim 1.

Additionally with regard to the rejection of independent claim 1 under Pepe, Applicants submit that Pepe does not disclose or suggest at least the limitation of "a profile of the media device stored in at least one of the following: the media device and the native communication device, the profile comprising information related to managing the media content when the media device is roaming," as disclosed by Applicants in independent claim 1. For example, Pepe does not teach or suggest that profile data is stored in a media device and/or a native communication device, as disclosed by Applicants in claim 1. Pepe teaches that customer profile data is stored by the Home Location Register (HLR) and the HLR is "maintained by the local telephone company of the user's home location." (Pepe, column 2, lines 9-19). Furthermore, Pepe also discloses that profile data may be obtained from a personal communication internetworking (PCI) server, which is maintained by the telephone service provider as illustrated, for example, in Figure 3 of Pepe (Pepe, column 22, lines 9-14). In this regard, the PCI server is neither a media device nor a native communication device, which is contrary to what is disclosed by Applicants in independent claim 1.

With regard to the rejection of independent claim 23 under Pepe, Applicants submit that Pepe does not disclose or suggest at least the limitation of "routing information associated with the media device in accordance with a profile of the media device, the profile being stored in at least one of the following: the native service location and the media device," as disclosed by Applicants in independent claim 23. For example, Pepe does not teach or suggest that profile data is stored in a media device and/or at a native service location, as disclosed

by Applicants in independent claim 23. Pepe teaches that customer profile data is stored by the Home Location Register (HLR) and the HLR is "maintained by the local telephone company of the user's home location." (Pepe, column 2, lines 9-19). Furthermore, Pepe also discloses that profile data may be obtained from a personal communication internetworking (PCI) server, which is maintained by the telephone service provider as illustrated, for example, in Figure 3 of Pepe (Pepe, column 22, lines 9-14). In this regard, the PCI server comprises neither a media device nor a native service location, which is contrary to what is disclosed by Applicants in independent claim 23.

With regard to the rejection of independent claim 26 under Pepe, Applicants submit that Pepe does not disclose or suggest at least the limitation of "the profile being stored in at least one of the following: a native communication device and the media device," as disclosed by Applicants in independent claim 26. For example, Pepe does not teach or suggest that profile data is stored in a media device and/or in a native communication device, as disclosed by Applicants in independent claim 26. Pepe teaches that customer profile data is stored by the Home Location Register (HLR) and the HLR is "maintained by the local telephone company of the user's home location." (Pepe, column 2, lines 9-19). Furthermore, Pepe also discloses that profile data may be obtained from a personal communication internetworking (PCI) server, which is maintained by the telephone service provider as illustrated, for example, in Figure 3 of Pepe (Pepe, column 22, lines 9-14). In this regard, the PCI server comprises neither a media device nor a native communication device, which is contrary to what is disclosed by Applicants in independent claim 26.

Based on at least the foregoing, Applicants believes the rejection of independent claims 1, 23 and 26 under 35 U.S.C. § 102(b) as being anticipated by Pepe have been overcome and requests that the rejections be withdrawn. Additionally, claims 2-3, 5-17, and 19-22 depend from independent claim 1 and

are consequently also respectfully submitted to be allowable. Furthermore, claims 24-25 and 27-29 depend from independent claims 23 and 26, respectively, and are consequently also respectfully submitted to be allowable.

Claim Rejections under 35 U.S.C. § 103

(Paragraphs 9 and 10 of the Office Action)

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Pepe. Claim 18 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Pepe in view of Alba.

With regard to an obviousness rejection, MPEP 2142 states that in order for a *prima facie* case of obviousness to be established, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. *Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.* Further, MPEP 2143.01 states that “the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination,” and that “although a prior art device ‘may be capable of being modified to run the way the apparatus is claimed, there must be a *suggestion or motivation in the reference* to do so” (citing *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)). Moreover, MPEP 2143.01 also states that the level of ordinary skill in the art cannot be relied upon to provide the suggestion...,” citing *Al-Site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308, 50 USPQ 2d 1161 (Fed. Cir. 1999).

With regard to the third criterion stated above and in reference to dependent claim 4, Applicants submit that Pepe does not disclose or suggest at

least the limitation of "the profile comprising control information indicating that downloaded information is stored in the native communication device when the media device is roaming," as claimed by Applicant in dependent claim 4. Additionally, the Examiner states in the Office Action (page 7) that Pepe does not specifically disclose the profile comprising control information indicating that downloaded information is stored in the native communication device when the media device is roaming, as called for in dependent claim 4. The Applicants respectfully agree.

Furthermore with respect to the rejection of claim 4 which depends from independent claim 1, the Applicants respectfully submit that Pepe does not render claim 4 unpatentable at least for the reasons discussed above with respect to independent claim 1.

With regard to the third criterion stated above and in reference to dependent claim 18, Applicants submit that neither Pepe nor Alba disclose or suggest at least the limitation of "the at least one wireless access point comprises at least one wireless fidelity access point," as claimed by Applicant in dependent claim 4. Additionally, the Examiner states in the Office Action (page 7) that Pepe does not specifically disclose the wireless access point comprises a wireless fidelity (WI-FI) access point, as called for in dependent claim 18. The Applicants respectfully agree.

Furthermore with respect to the rejection of claim 18 which depends from independent claim 1, the Applicants respectfully submit that Pepe in view of Alba do not render claim 18 unpatentable at least for the reasons discussed above with respect to independent claim 1.

Based on at least the foregoing, Applicants believe the rejection of dependent claim 4 under 35 U.S.C. § 103(a) as being anticipated by Pepe has been overcome and requests that the rejection be withdrawn. Additionally,

Applicants believe the rejection of dependent claim 18 under 35 U.S.C. § 103(a) as being anticipated by Pepe in view of Alba has been overcome and requests that the rejection be withdrawn.

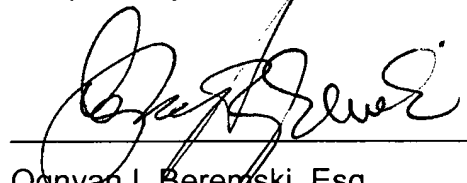
CONCLUSION

Based on the foregoing, Applicant believes that all claims 1-29 are in condition for allowance. If the Examiner disagrees, Applicant respectfully requests a phone interview, and requests that the Examiner telephone the undersigned at 312-775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Ognyan I. Berenski', is written over a horizontal line.

Ognyan I. Berenski, Esq.
Registration No. 51,458
Attorney for Applicant(s)

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MCANDREWS, HELD & MALLOY, LTD.
500 West Madison Street, 34th Floor
Chicago, Illinois 60661
(312) 775-8000